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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,864	04/13/2004	Hiroshi Ichikawa	64903-024	2673

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MCDERMOTT, WILL & EMERY
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Washington, DC 20005-3096

EXAMINER

KUMAR, KALYANA VENKA K

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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12/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/822,864

Applicant(s)

ICHIKAWA ET AL.

Examiner

Kalyan Kumar

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 1, the claim recites, "multiple banknote discrimination modules," it is unclear if this phrase is referring to multiple banknotes or multiple modules.

Clarification is requested.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1-3, 6-8, 11-15, 18-23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hirose (USP 4,479,049)** in view of **Jones et al (USP 6,128,402)**.

7. Regarding claims 1, 11, 12, 14, 15, 18- 23, and 25 Hirose discloses a banknote handling system and method, comprising: a money in-out slot (6) that receives or pays out banknotes from or to each customer; a banknote conveyance module; multiple banknote discrimination modules (24) for discriminating each conveyed banknote in a money-in process in which banknotes are inserted in money in-out slot, as well as in a transaction process that is accompanied with the conveyance of banknotes; a banknote storage box (63) for storing a banknote determined as genuine by banknote discrimination module; and a reject box (29) for storing a banknote found undeterminable by banknote discrimination module; a counterfeit collection box (64; it is capable of being a counterfeit collection box), which is different from banknote storage boxes for collecting a banknote determined as counterfeit by banknote discrimination module, but Hirose does not disclose a control unit that, when a banknote is fed from banknote storage box or a banknote is stored in the banknote storage box, controls the management module to update the source data of the fed banknote or the

stored banknote corresponding to the banknote storage box, a management module for managing information on the transaction process with respect to each banknote, information including transactor information identifying the transactor who has given a banknote stored in counterfeit collection box wherein management module updates the managed information of a banknote when the banknote is fed from the banknote storage box. Jones teaches a control unit (34) that controls a management module (30) and updates the source data of the banknote corresponding to the banknote storage box to be related to the counterfeit collection box, when the banknote is fed from the banknote storage box and the source data includes a transaction record ID and transactor information comprising an account number and an employee number (10b) for the purpose of increased control and efficiency in storing and utilizing characteristic information for comparison (col. 18, lines 39-46). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hirose's device to have a control unit and a management unit, as taught by Jones, for the purpose of increased control and efficiency in storing and utilizing characteristic information for comparison.

8. Regarding claims 2 and 3, Hirose/Jones discloses a temporary storage box (Jones, elements 25-28) that temporarily keeps the banknote determined as genuine by said banknote discrimination module in the money-in process, prior to storage of the banknote into said banknote storage box, wherein the transaction process comprises a deposit cancellation process that receives a customer's input of a cancellation

instruction and feeds back the banknote temporarily kept in said temporary storage box to said money in-out slot (Jones, elements 11d, 11b, and 11p).

9. Regarding claim 6, Hirose/Jones discloses the transaction process comprises a banknote feed process that supplies banknotes to said banknote storage box from a place other than said money in-out slot (it's inherent that during opening and maintenance of the cassettes that old money out taken out of the banknote storage boxes and new money would be put it, therefore a different mode money to get into and out of the banknote storage boxes).

10. Regarding claims 7 and 8, Hirose/Jones discloses a cassette detachably attached to said banknote handling system, wherein the banknote feed process feeds out banknotes kept in said cassette attached to said banknote handling system and conveys the banknotes to said banknote storage box for storage (Jones col. 8, lines 44-46).

11. Regarding claim 13, Hirose/Jones discloses a banknote-sorting module (Jones, elements col. 9, lines 19-20).

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose in view of Jones and in further view of **Guibord et al (USP 4,340,150)**.

13. Regarding claim 5, Hirose/Jones discloses all the limitations of the claim, but Hirose/Jones does not disclose a left-money collection process that stores or collects a banknote. Guibord teaches a left-money collection process that stores or collects a banknote for the purpose of recovering dispensed cash or notes automatically in certain conditions when abnormal or erroneous operation has been detected (col. 1, lines 64-

66). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hirose/Jones's banknote handling system with a left-money collection process that stores or collects a banknote, as taught by Guibord, for the purpose of recovering dispensed cash or notes automatically in certain conditions when abnormal or erroneous operation has been detected.

14. Claim 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose in view of Jones and in further view of **Yukimoto et al (USP 5,605,214)**.

15. Regarding claim 24, Hirose/Jones discloses all the limitations of the claim, but Hirose/Jones does not the management module manages the source data with a banknote number sequentially allocated to each banknote stored in the banknote storage boxes and when a banknote is fed from the banknote storage boxes, the control unit changes the banknote number allocated to the banknote. Yukimoto teaches the management module manages the source data with a banknote number sequentially allocated to each banknote stored in the banknote storage boxes and when a banknote is fed from the banknote storage boxes, the control unit changes the banknote number allocated to the banknote for the purpose of sequentially stacking and accumulating the authentic banknotes (col. 1, lines 17-22). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Hirose/Jones's banknote handling system to store banknotes sequentially, as taught by Yukimoto, for the purpose of sequentially stacking and accumulating the authentic banknotes.

16. Regarding claims 4, 9-10, and 16-17, the claims have been canceled.

Response to Arguments

17. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kalyan Kumar whose telephone number is 571-272-8102. The examiner can normally be reached on Mon-Fri 7:00AM-3:30PM.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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SUPERVISORY PATENT EXAMINER
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Kalyan Kumar

Examiner

Art Unit 3653